

REMARKS/ARGUMENTS

In the restriction/election of species requirement dated October 30, 2006, the Examiner delineated the following inventions as being patentably distinct:

Group I, Claim(s) 1-12, drawn to a peptide composed of at least 23 residues.

Group II, Claim(s) 13, drawn to a method of treating or preventing one or more symptoms from the group consisting of ischemic cerebrovascular disorder.

The Examiner further required the election of a single disclosed species.

Applicants provisionally elect Group I, and the species of Claim 7, both with traverse.

The claims of Groups I and II are integrally linked as compounds and method of use.

Restriction is only proper if the claims of restricted groups are either independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinction. Compounds and method of use should be examined together. It is a technical relationship that involves the same features, and it is their technical relationship that defines the contribution which each of the Groups taken as a whole makes over the prior art.

In chemical cases, a specified group of materials which do not necessarily belong to an otherwise class can be claimed together employing "Markush" language. The Markush practice sanctions the claiming together operable substances which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics. The members of the Markush grouping only possess at least one property in common which is mainly responsible for the function of the chemical relationship. The same utility in a generic sense suffices.

Moreover, the MPEP at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants submit that a search of all claims would not constitute a serious burden on the Office. In fact, the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that restriction should now be required when the International Preliminary Examination Report did not, restriction is believed to be improper.

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

Applicants request that if the invention of Group I is found allowable withdrawn Group II which includes all the limitations of allowable claims be rejoined.

Applicants request that should the elected species be found allowable, the Examiner expand her search to include non-elected species.

Divisional applications filed thereafter claiming the non-elected species should not be subject to a double patenting ground of rejection 35 USC 121, In re Joyce (Comr Pats 1957) 115 USPQ 412.

Applicants submit that the above-identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.


Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)



Paul J. Killos
Registration No. 58,014